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JOHN A. BRILL AND THE J. G. BRILL COMPANY
Petitioners

vs.

THE PECKHAM MOTOR TRUCK AND WHEEL COMPANY *et al.*
Respondents

SUPPLEMENTAL BRIEF FOR PETITIONERS

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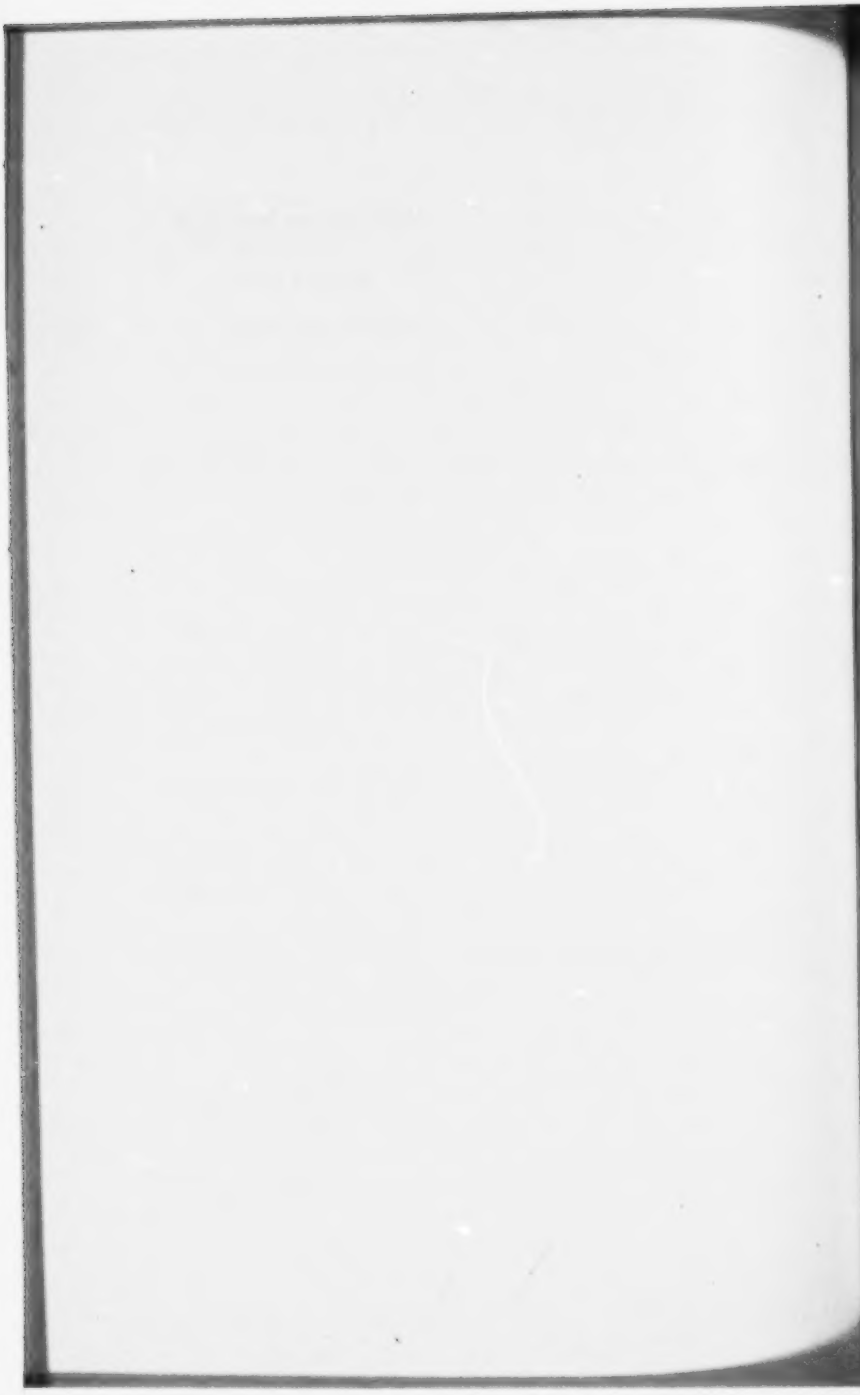

In the United States Supreme Court.

JOHN A. BRILL AND THE J. G. BRILL COMPANY,
Petitioners,
Against
THE PECKHAM MOTOR TRUCK & WHEEL CO., *et al.*,
Respondents.
In Equity.

SUPPLEMENTAL BRIEF FOR PETITIONERS.

The Supplemental Brief for respondents is more significant for what it omits to say than for what it says. And the same thing is true of the Brief filed before the argument.

MATTERS NOT TREATED IN RESPONDENTS' BRIEFS.

Neither Respondents' Brief nor their Supplemental Brief seriously touches upon the following vital arguments made on behalf of the Petitioners.

1. *As to whether the specification imposes any limitation upon the broad Claims 1 and 2.* This subject is treated in Petitioners' Brief at pages 46 and 97. Respondents' Brief refers to the language of the specification in this connection, but the Supplemental Brief does not attempt to meet the arguments presented by the Petitioners' Brief.

2. Neither Brief touches upon the Petitioners' argument based upon a comparison of two passages in the specification

in which the same operation of the truck is described, in one passage, by the use of the word *abnormally*, and in another passage, without that word, clearly showing that "*abnormally*" is not a word of definite significance in that connection.

3. Neither Brief touches on the Petitioners' argument (pp. 47, 98) that the existence of a broad group of claims and a limited group of claims is to be taken as a most persuasive consideration that the intent, to be gathered from the whole patent, is to cover the broad invention.

4. Neither Brief touches upon the Petitioners' argument (pp. 49, 99) in reference to the *drawings* of the patent as showing *simultaneous* compression of both sets of springs under the *car body weight alone.*

5. Neither Brief makes any reference to the argument in Petitioner's Brief (p. 56) to the effect that, even with a limitation placed upon Claims 1 and 2, the Respondents infringe (assuming the operation of their trucks to be as set forth in the opinion of the Court below).

6. Neither Brief *seriously considers* the Peckham patent 419,876 as imposing a limitation upon Claims 1 and 2. The original Brief barely touches the subject by quoting from the opinion of the Court below and quoting some inconclusive matter from one of their expert witnesses—nothing more. The Supplemental Brief adds no argument.

7. Neither Brief controverts the positions in regard to this Peckham patent taken in Respondents' Brief:

That it is a mere paper patent.

That its truck was never used and is incapable of use.

That its *frame* is not the frame of the patent in suit.

That its *spring system* is not the spring system of the patent in suit.

That it has been *rejected* at every stage in the history of this litigation, beginning at the Patent Office (excepting, of course, by the Court below).

That it is entirely out of touch with the entire development of the electric railway truck art.

8. Neither Brief attempts to sustain the opinion of the Court below in holding that it was not necessary for Judge Shipman, in the Third Avenue case, "to define accurately" Claims 1 and 2 (see Petitioners' Brief, p. 129).

The last three considerations are very important. The Respondents' Counsel asks this Court to sustain the rulings of the Court below, and yet fails almost completely to present any supporting argument on their behalf. The Court below, in reaching its conclusions, first considered that Judge Shipman's definition of Claims 1 and 2 was not a necessary part of his decision, and therefore need not be followed. We believe that we have shown in our Brief (p. 129) that in this respect the Court below was in error. Respondents, by their failure to meet our showing, would seem to yield the point.

The Court below having thus disposed of Judge Shipman's ruling, took up the Peckham patent 419,876, which Judge Shipman had held to be irrelevant to the case, and, setting aside Judge Shipman's finding, proceeded to hold that it imposed a limitation upon the broad Claims 1 and 2. Here again Petitioners' counsel, in their Brief, adduced what they consider persuasive reasons for a different view of this Peckham patent, and these arguments are not met by either of the Respondents' Briefs.

The Court below further proceeded to find that the language of the specification likewise imposed a limitation upon the broad claims 1 and 2, and here also Respondents' Brief substantially fails to support of the view of the Court below or to meet what we believe is a controlling argument on behalf of the Petitioners.

In fact Respondents' counsel seem to find themselves in the unfortunate, though not uncommon position, of having had the Court below base its decision in their favor upon reasons which they apparently believe to be untenable, while paying no regard to the reasons which both they and their predecessor in the Court below, Mr. Wells, considered as the only possible ground of defense upon which they could hope to prevail, viz., the employment of their underlying tension spring as their only means of lessening oscillation.

9. The Respondents' theories, upon which they depend as showing that their trucks do not infringe, are considered in Petitioners' Brief (pp. 109–124) and are, we believe, there shown to be untenable. No part of this argument is met or touched on in either of Respondents' Briefs.

In this connection we call attention to certain matters in the description of the Respondents' trucks at page 12 of Respondents' original Brief. Respondents' springs are there described as if they were held between the jaws of a vise, and the inference is drawn that therefore there is *simultaneous* compression of both sets of springs *at all times*. But counsel for Respondents overlook the fact that *when the parts were assembled* (that is, when the car body was first lowered upon the springs), one set of springs came under compression before the other set, and it was *only when the weight of the car body is on the truck* that there is this simultaneous compression. We show in our Brief (pp. 43, 44, 45, 99) that this is precisely the method of *use* of the truck of the patent in suit; that is, that there is a simultaneous compression of both sets of springs under the car body weight alone. A truck, like every other machine, ought to be considered *when in use*—doing its work; not as an abstract structure standing by itself, but a truck with a car body on it, and in operation. In this condition and from this point of view, *both structures* have *simultaneous* compression of both sets of springs. The

difference between the two structures is that in the Respondents' truck the elliptic spring is tied at the top, while in the truck of the patent in suit it has a loose contact with the upper chord.

It will be remembered that the Court below found that in Respondents' trucks "both sets of springs are brought into action and begin to compress simultaneously *when the weight upon them is greater than the weight of the car.*" (Petitioners' Brief, p. 44.)

10. Neither of the Respondents' Briefs attempts to meet the Petitioners' argument at p. 88 of their Brief, that the fact that the truck of the patent in suit had been universally adopted is, under the authorities, entitled to weight, and is sufficient to resolve any doubt as to patentable novelty, in favor of the patentee. (The Respondents seem to deny that the truck of the patent *has* taken the market. If so, this is an excellent reason for sending the case to a final hearing on this question of fact.)

We come now to consider certain matters treated by the Respondents' Briefs.

As to the Doctrine of Comity and Its Application.

While one of the main questions in the case necessarily involved this rule and the propriety of its application to the case at bar, the original Brief makes no reference to this subject.

The Supplemental Brief touches upon it, but in such a way, we submit, as to strengthen the petitioners' argument. (See Petitioners' Brief, pp. 21-30.) Petitioners' counsel at the argument did not contend (and in view of the language of this Court in *Mast, Foos & Co.* vs. *Stover Manfg. Co.* could not have contended) that comity is a rule of obligation, but that it is a rule that should be applied in a proper case and that the case at bar was eminently such a case, and it was pointed out

that the prior adjudication was in the same Court and made upon final hearing upon pleadings and proofs after a protracted litigation. This Court said in the Mast-Foos case: "So, too, if a prior adjudication has followed a final hearing upon pleadings and proofs, especially after a protracted litigation, greater weight should be given to it than if it were made after a preliminary injunction."

Cases are cited in the Petitioners' Brief (pp. 23-29) to the effect that a prior adjudication should be followed on a motion for a preliminary injunction,

> "Except upon a *clear showing* that the decision invoked in its favor *was wrong.*" (*Electric Mfg. Co.* vs. *Edison Electric Light Co.*, 61 Fed. Rep. 834.)

> "Unless it *clearly appears* that the Court below has *fallen into a misapprehension* respecting the facts or law of the case in a *matter vital to the issue.*" (*Loew Filter Co.* vs. *German-American Filter Co.*, 107 Fed. Rep. 949.)

> "Unless it appears, after a consideration of all the evidence upon which his action was based, that *his legal discretion* to grant or withhold the order was *improvidently exercised.*" (*So. Pacific Co.* vs. *Earle*, 82 Fed. Rep. 690.)

> "In the absence of some *controlling reason* for disregarding it." (*Consolidated Fastener Co.* vs. *Littauer*, 84 Fed. Rep. 164.)

> Except "in a case of *clear mistake of law or fact*, of newly discovered testimony, or upon some question not considered by the Court." (*Heaton-Peninsular Co.* vs. *Elliott Co.*, 58 Fed. Rep. 220.)

The cases cited in the Supplemental Brief all belong to the class of *exceptional cases* in which, for "*controlling reasons*," the Circuit Courts of Appeals have deemed it their duty to re-examine the prior adjudications. We will briefly take them up in order:

Thus, in *Curtis* vs. *Overman Wheel Co.*, 58 Fed. Rep. 784, Shipman. J., followed that course upon the ground that "the vital question in this case is presented with approximate accuracy upon the face of the patent, and does not depend upon controverted questions of fact."

In *Thomson-Houston Electric Co.* vs. *Hoosick Ry. Co.*, 82 Fed. Rep. 461, the Circuit Court of Appeals for the Second Circuit re-examined the former adjudication because "the question of whether two patents are for the same invention is a question which is to be determined by a comparison of the documents themselves. There may be cases in which it is necessary to resort to extrinsic evidence to ascertain the meaning and the true construction of the documents. The present was not such a case." The question there was as to whether Van de Poele's earlier patent was for the same invention as his patent in suit.

Thomson-Houston Electric Co. vs. *Union Railway Co.*, 86 Fed. Rep. 636, was a suit upon the same patent as was involved in the last mentioned case, and raised the same question.

Sprague Electric Ry. Co. vs. *Nassau Electric Ry. Co.*, 95 Fed. Rep. 821. Here the Court of Appeals reversed the order for a preliminary injunction granted on the prior adjudication upon the ground that the theory of infringement depended upon the determination of two questions; that the first of these questions had "*not been touched upon by any of the previous adjudications* upon the patent"; and that the

second of them involved a doubtful question of fact. Further, "that the questions thus suggested are too doubtful to be resolved upon a motion for a preliminary injunction and should be reserved until the final hearing of the cause."

In *American Graphophone Co.* vs. *National Gramophone Co.*, 92 Fed. Rep. 364, the Court did not review the prior adjudication, but examined it in order to "*ascertain the scope of the decision.*" The Court considered that the injunction below had been granted on a *misunderstanding of the scope of that decision* and the order for an injunction was reversed.

In *Whippany Mfg. Co.* vs. *United Indurated Fibre Co.*, 87 Fed. Rep. 215, there was not only much conflict as to the facts, but further than that, the Court said:

> "The complainant's patent was sustained by the Circuit Court of New Jersey in a suit against the New York Wood Fibre Company; but it does not appear that the construction there given it was *such as is now claimed* and broad enough to cover the respondents' process, and thus subject them to the charge of infringement."

In *Horn & Brannen Mfg. Co.* vs. *Pelzer*, 91 Fed. Rep. 665, Acheson, C. J., in delivering the opinion of the Court, referred to the "great importance" of the rule of comity, but said:

> "In the present case, however, the *circumstances are so unusual* that we are *constrained* to make an independent investigation, etc."

It appeared there that the defendant's device was manufactured under a patent antedating complainant's re-issued patent which it was alleged to infringe, and that twelve years had elapsed between the date of the original patent, which had been held void, and the application for the re-issue of that

same patent. The Court proceeded to hold the re-issued patent void by reason of the delay in applying for it.

Seiler vs. *Fuller & Johnson Mfg. Co.*, 102 Fed. Rep., 344, was a case of a *restraining order* made *pending a motion* for a preliminary injunction. The Court of Appeals, in vacating the restraining order, said:

> "The fact of infringement, however, did not sufficiently appear to warrant an injunction. It was alleged in the bill in general terms, and flatly denied by the answer. *No proofs were presented of the character or construction* of the *infringing machine*, or in what respect, if at all, it did infringe. . . . We therefore think the court below, in granting the temporary restraining order, exceeded a just discretion in restraining the defendants before it had passed upon the question whether there was in fact infringement."

Even under these circumstances, the Court said:

> "It is a *delicate matter* to interfere with the discretion exercised by the court below in a matter of this kind."

We have never denied the *right* of the Circuit Court of Appeals to examine the whole case before it, and to re-examine the prior adjudication. The cases cited by respondent's counsel, when analyzed, are shown to support rather than weaken the rules for which we contend, viz.:

1. The prior adjudication should be followed in the absence of some controlling reason for disregarding it.

2. That the prior adjudication is entitled to the same weight in the Circuit Court of Appeals which it had in the Circuit Court.

3. That on appeal from an order granting preliminary injunction the Circuit Court of Appeals will consider only

whether the lower court exercised reasonable discretion in granting a preliminary injunction.

We may add that respondents' counsel, in their argument at bar, made slight or no reference to the comity rule, or to any of the authorities cited in the petitioners' brief in favor of its application to the case at bar.

As to whether the Court below was Justified under the Mast-Foos Case in Dismissing the Bill.

Respondents' counsel devoted but little, if any, of their attention in the argument at bar to this branch of the case. The following position and argument from their original Brief would seem, in effect, to admit the point that we contend for, viz.: that the Petitioners are entitled to have their bill reinstated and to go to final hearing. They are as follows:

As we have stated in our Brief and at the argument, the Respondents' defence has been based chiefly, if not almost entirely, both in the court below and in this court, upon their contention that they do not use the elliptical springs of the patent at suit for the purposes of lessening oscillation, but that they reach that result in their trucks by the use of their underlying *tension spring*, and that they use elliptical springs merely for bracing the car-body—with the added thought, upon which they also strongly insist, that their elliptical springs are tied to the upper chord, or car-body.

These theories are largely developed in the Respondents' Brief used at the hearing, occupying therein much more space than any other part of the argument. After describing their trucks, and what they claim to be their method of operation, and after stating that elliptical springs were adopted by Peckham for the purpose of preventing the swaying of the car-body " and for this purpose alone " (Respondents' Brief, p. 18), the Brief proceeds to consider certain *experiments* performed in this connection by the Respondents and their experts after the filing of the bill in this case and before the

motion for the preliminary injunction was heard—a period of about eleven days.

The Brief states in regard to this as follows (p. 18):

> "The practical experimental demonstrations, immediately hereinafter described, show beyond question that the introduction of the elliptical springs into the Peckham trucks is a positive detriment; the amount of galloping being the same, while the motion is much easier on both passengers and car when all spiral springs, without any elliptic, are used."

Under this head the Respondents' Brief then proceeds to describe the result of their experiments, and sums up these results as follows (p. 23):

> "These experiments *would seem to demonstrate conclusively* that Peckham's elliptic springs do not perform the function claimed for the elliptic springs in the patent in suit. Indeed, as far as galloping goes, their introduction into the Peckham truck is demonstrated to be a positive disadvantage, and the only reason for their continued use all these years is that stated by the Respondents; *i. e.*, to prevent the latteral swaying of the car body."

Again at page 25 of the same Brief it is stated, referring to the Circuit Court of Appeals:

> "In comparing Respondents' trucks with the claims as construed, it had, on the one hand, the sworn statement of Mr. Livermore that the elliptical springs of defendants' trucks were slower in action than the spiral springs. *Against this it had the sworn statements* of Messrs. Peckham, Newbury, Fowler and Abbott that both sets of springs were brought into action and began to compress simultaneously. *The latter statements were based upon a series of carefully authenticated tests.*"

It will be observed that these "carefully authenticated tests" were made by the Respondents in private, and that their alleged results were brought into the case by *ex parte* affidavits, which the complainants' counsel were not permitted even to inspect until the argument of the motion for preliminary injunction had actually been begun, and to which, of course, they were not permitted to reply. In fact, all that complainants' counsel could learn at the argument in the Circuit Court as to these affidavits, which cover about 52 pages of the printed Transcript of Record, was what they could run through (in typewritten shape) in the half hour of argument occupied by complainants' counsel in opening the case and defendants' counsel in replying, leaving about ten minutes for the closing argument of complainants' counsel on about 75 pages of typewritten matter which had been handed to him half an hour before.

The Respondent's Brief continues:

> "The Petitioners tendered this issue to Respondents' (p. 23) . . . (p. 24) and Respondents accepted the test, and their proofs (heretofore referred to) to sustain their contention that both sets of springs are brought into action and compressed simultaneously, were so *overwhelming* that the Court found, etc."

Thus the entire question of the construction and mode of operation of Respondents' trucks and the finding of the Court on that main issue of the case were based upon "overwhelming" evidence, taken *ex parte* and never seen by the Petitioners' counsel till the argument in the Circuit Court had begun.

Surely, nothing further is needed to show that the Petitioners are entitled to go to final hearing, so that they may test the value of this evidence by the cross-examination of the witnesses called to substantiate it.

And there even seems to be a difference between the infer-

ences drawn from these "overwhelming" proofs by the Court below in its opinion and in the Brief for Respondents. The former holds that "in the car trucks of the defendant, both sets of springs are brought into action and begin to compress *simultaneously when the weight upon them is greater than the normal weight of the car*," while the result of the same experiments is set forth on page 25 of Respondents' Brief in these words:

> "Against this it had the sworn statements of Messrs. Peckham, Newbury, Fowler and Abbott, that both sets of springs were *brought into action and began to compress simultaneously*."

The difference is important. Which view is the correct one? We submit that nothing but a final hearing can answer the question.

These considerations, we urge, conclusively demonstrate that the Court below committed a grave error in dismissing the bill.

Respondents' Brief, at page 27, considers the different reasons urged by Petitioners as to why the bill of complaint should not be dismissed. We are told that our claim to produce evidence as to the actual operation of Respondents' devices, as compared with the devices of the patent in suit, is a mere prayer to have the case reopened because our proofs were insufficient to prove our case. But the "case" was a motion for preliminary injunction, and the evidence we claim the right to produce is evidence to be used at final hearing on the merits.

We are told that if we wish to adduce testimony as to the defendants' devices we should be relegated to a new suit, but we fear that a more serious defense would then be interposed if this decree be allowed to stand and another suit is begun on the same right of action.

Again, we are told (p. 28) that we "could not controvert Respondents' affidavits." But, obviously, the question is not whether we can controvert these affidavits, but whether we are not entitled to an *opportunity to do so.*

With reference to Petitioners' claim that they are entitled to adduce proofs as to how the Peckham patent 419,876 would operate, the Respondents' counsel argues that such evidence would be "immaterial as to any possible issue in this suit," also, "it is entirely immaterial whether or not the particular Peckham patent is or is not capable of practical use."

We reply to this that patent law deals with practical questions, and certainly the question as to whether an alleged prior art patent is a practical device and taught anything to the art, and whether or not it was capable of use, must certainly always be immaterial in the consideration of its bearing upon a patent of later date.

The Petitioners claim the right to produce evidence that the conception of the invention of the patent in suit antedates the only two alleged prior art patents, Manier and Peckham.

Considering this contention, the Respondents' Brief makes a very vital admission. It fully admits the date of the conception of the invention of the patent in suit as of May, 1889, that is, prior to both Manier and Peckham dates. It, however, argues that Mr. Brill was not diligent in reducing his invention to practice, and while he delayed, both Manier and Peckham made their inventions and received patents therefor. The reply is obvious. Admit that Mr. Brill was first in the field, the law allows him to explain the reason for his delay. Mere lapse of time would deprive him of no right; only unnecessary and unexplained delays would have that effect. If he were sick or too poor to experiment, or if nobody would buy his invention or try it (and it could only be tried on an actual railway)—these and many other reasons would leave his rights unimpaired. Clearly we are entitled to adduce evidence to show why he delayed, if there was, in fact, any delay.

But more than this, the "race of diligence" in such a case is only between inventors of the same device. It is not be-

tween an invention and a prior art patent set up merely to show that some feature or other of the invention was lacking in novelty. There could be no race of diligence in this sense between the patent in suit and either Manier or Peckham.

For the sake of brevity, other considerations in Respondents' Brief as to the Petitioners' reasons for claiming a right to go to final hearing must be passed over. The arguments advanced really require no consideration. One of them is as follows: "To quiet litigation, this Court should frown upon the attempt to harrass and annoy the Respondents in the manner shown by this proceeding."

The Respondents Suggestion that the Third Avenue Case before Judge Shipman was a Friendly Suit, etc.

This is a new contention in the case and *is absolutely without foundation, in fact. No such question* was raised at any stage in the Court below, or in the Respondents' Brief on the petition for the writ of *Certiorari;* nor even in the Respondents' Brief, filed before the argument. The owner of the patent in suit, desiring to reach the Bemis Car Box Company, a competitor in business who was infringing the patent here in suit, brought suit in the Southern District of New York against a *user* of Bemis trucks, instead of against the Bemis Car Box Company in the District of Massachusetts, in which their works were situated. The Bemis Company who built the Third Avenue trucks retained Messrs. Briesen & Knauth, well-known patent lawyers, to defend the case. The Defendant's Record in the Third Avenue Case (a copy of which is now before this Court) contains, at page 77, the following statement by counsel:

> "Defendant's counsel, in order to prevent further delay, admits that the Bemis Car Box Company of Springfield,

Massachusetts, is defending the present suit for the Third Avenue Railway Company."

The same Record shows that Mr. v. Briesen signed the defendant's answer as counsel. The Record shows that either he or some one associated with him, attended all the meetings and examined and cross-examined the witnesses, and Mr. v. Briesen argued the case before Judge Shipman.

Judge Shipman, in his opinion (Transcript of Record, p. 140) says: "One hundred and eighty-one infringing trucks were purchased by the defendant from the Bemis Car Box Company, of Springfield, Massachusetts, which, it is admitted, 'is defending the present suit for the Third Avenue Railroad Company.'"

The Supplemental Brief states that the Bemis Company sought to intervene in the cause, but that their petition was opposed by counsel for complainant (the present petitioners) and was denied.

This is incorrect. The writer was counsel in that case and submitted the matter to such order as the Court might make, being only unwilling to have an intervention order made by stipulation. Whether there was a technical *intervention* or not was entirely immaterial, for the Bemis Company had, at every stage of the cause, *full and absolute contact of the entire proceedings*. The statement in the Supplemental Brief at p. 4, that "the maker of the trucks did not have full control" of the defense, *is not true*.

The next statement in this connection made in Respondents' Supplemental Brief (top of page 5) to the effect that the defendant's superintendent, Robertson, was called by the plaintiff, but opportunity for defendants' counsel to cross-examine him was not granted (p. 5) is likewise untrue, as will appear from the Third Avenue Record. It shows that while he was on the stand and after the taking of testimony had been twice adjourned on account of the absence of Mr. v. Briesen, complainant's counsel merely insisted that Mr. v. Briesen's associate in the case, who had been actively en-

gaged with his senior, Mr. von Briesen, in the conduct of the case, should proceed with the cross-examination of the witness, which he thereupon did.

The situation is perfectly simple. The Third Avenue Company were customers of the Brill Company, as well as of the Bemis Company, being one of the largest railways in the country, and it would have been poor policy for the Brill Company to antagonize them further than was necessary. They understood that the suit was in effect, against the Bemis Company, and such it became and was to the end. This is all that could have been meant by the statement from the Defendant's Record in that case set forth on page 4 of the Supplemental Brief, to the effect that counsel for the Brill Company "had received permission to bring such a suit" against the Third Avenue Railway Company.

It was a matter of no importance as to whether such employees of the Third Avenue Railway Company as were called as witnesses appeared with or without subpœnas. As a matter of fact, two were subpœnaed and one came without a subpœna.

Again, *it is not true* that "while the testimony was being taken its interest [that of the Bemis Car Box Company] ceased by the fact that the trucks complained of were discarded by the Third Avenue Railroad Company" (Suppl. Brief, p. 4). It is enough to say that after that fact appeared on the Record of the Third Avenue Case, Messrs. Briesen & Knauth attended the examination of the eight more witnesses in Philadelphia, whose testimony covered some fifty printed pages of the Record, and the same experienced counsel spent a day in arguing the case before Judge Shipman upon an elaborate and full brief covering about sixty pages.

It is stated in the Supplemental Brief that "no appeal was taken, and so far as the record discloses, no attempt was ever made to utilize this adjudication against the Bemis Company." It is hardly ground for disregarding the final adjudication of Judge Shipman that no appeal was taken, rather the con-

trary. And it is not understood how the Record could show that his adjudication was or was not utilized further against the Bemis Company.

But after all, the enormous Record in the Third Avenue Case, which is now a part of the Transcript of Record in the case at bar, is the best reply to this novel and baseless contention of the counsel for the Respondents. The Third Avenue case was *not* a friendly suit, but was a real litigation—contested at every stage on behalf of the builders of the infringing trucks, as to whom it was well understood to be a test case reaching far beyond the few trucks in controversy in that case. Judge Wallace, in the opinion of the Court below (Record, p. 150), says that "in that action the claims . . . and the question of their validity as well as their infringment was *strenuously contested*."

The Petitioners were not permitted in the Circuit Court to file rebutting affidavits.

Respondents' counsel are mistaken in their Brief, at pages 28, 33, as to filing rebutting affidavits. The facts are not on the Record and will therefore have to be stated by the writer who was present in Court; the present counsel for Respondents was not then acting in the case. The facts are these: The motion for a preliminary injunction, on four days' notice, came up on a Friday list before Judge Lacombe. The Defendants' counsel applied for one week's continuance. This was granted. The Complainant's counsel thereupon asked the Court to direct that the Defendants' affidavits be served not later than the second day before the hearing of the motion. Judge Lacombe declined to make such an order, and directed that they be served when the case was called for hearing. They were, in fact, exhibited to Complainants' counsel after the argument on the motion for a preliminary injunction had begun.

Respondents' Contention that the Petitioners were guilty of Laches.

The argument in the Supplemental Brief (p. 5) that the Petitioners were guilty of *laches* is entirely *new in the case.* The Transcript of Record, pages 59, 60 and 61, shows that the Respondents were notified in 1897 that they would be held responsible for the infringement of the patent in suit, and that a test case would be instituted for that purpose. The test case against the Third Avenue Railroad Company was thereupon brought and pushed to a final hearing and these proceedings followed immediately upon the final decree in that case. Respondents, as shown in the affidavit of Hensley (Transcript of Record, p. 59) took the position that the patent was invalid, and their acts have therefore been deliberate. They simply *chose* to infringe and stand the consequences. So far as future consequences which would follow on an injunction are concerned, they can avoid them by dispensing with the elliptical spring, which they say at page 23 of their Brief "is demonstrated to be a positive disadvantage; and the only beneficial function they can perform—the only reason for their continued use all these years' is that stated by the Respondents; *i. e.*, to prevent the lateral swaying of the car body."

In *McLean* vs. *Fleming*, 96 U. S. 345, a trade-mark case, this Court said:

> "Equity courts will not in general refuse an injunction on account of delay in seeking relief, when the proof of infringement is clear, even when the delay is such as to preclude the party from any right to business profits."

New York Filter Co. vs. *Jackson*, 19 Fed. Rep. 422.

Where the defendant was notified by the complainant that complainant owned a monopoly, etc., a delay of five years in beginning suit for infringement, during which time the com-

plainant was engaged in litigation with other infringers, was not such laches as will bar relief by preliminary injunction.

Green vs. *Barney*, 19 Fed. Rep. 420:

> "When the validity of a patent is in litigation, the patentee may, without being guilty of laches, wait until a decision is rendered before bringing suit against other infringers."

To the same effect, *North* vs. *Eagle Automatic Can Co.*, 57 Fed. Rep. 929.

As to the reference in the Supplemental Brief, page 7, to "Lord Baltimore" trucks in use in Washington. They are trucks under short car bodies, whereas the present controversy relates to pivotal trucks under long car bodies. The use of these "Lord Baltimore" trucks does not, therefore, qualify the statement that the truck of the patent in suit has been universally accepted under long cars.

We submit that nothing in the argument at bar, or in either of the Briefs, affects in any way the force of the arguments on behalf of the Petitioners.

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